

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Confirmation No. 9653

MIAN et al.

Atty. Ref.: 3772-38

Appln. No. 10/533,935

T.C. / Art Unit: 1657

Filed: May 4, 2005

Examiner: R.J. Gitomer

FOR: QUANTIFYING EXPOSURE TO STRESS

* * *

PETITION UNDER 37 CFR §§ 1.144 AND 1.181

October 30, 2009

Mail Stop Petition

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants petition the Director to invoke his supervisory authority and to review the Examiner's final restriction requirement. In accordance with M.P.E.P. § 1002.02(c), it is understood that authority to decide this petition may be delegated to a Technology Center Director.

The Rule 17(h) fee of \$130 for this petition is attached. If the fee is missing or deficient, authority is given to charge any deficiency in the fee which should have been filed herewith to our Deposit Account No. 14-1140 under Order No. 3772-38.

ISSUE IS RIPE FOR REVIEW

Although claims 1, 5, 7-14, 16-17 and 24 were searched and examined in prior Office Actions, a restriction requirement was made in the Office Action mailed August 11, 2009. Applicants traversed the requirement in their response filed September 11, 2009. Claims 1, 5, 7-11 and 24 were elected.

The restriction requirement was made final in the Office Action mailed October 16, 2009. Claims 12-14 and 16-17 were withdrawn from consideration by the Examiner.

It is respectfully requested that the Director invoke his supervisory authority to review the restriction requirement so that all of the pending claims are examined in this patent application.

This petition is timely because the restriction requirement was made final and an appeal has not yet been filed in this patent application.

STATEMENT OF FACTS AND POINT(S) TO BE REVIEWED

Claims 1-14 and 16-22 were presented for examination on May 4, 2005. Examiner Wood made a restriction requirement in her Office Action mailed March 24, 2006. Applicants elected claims 1-14 and 16-21 for examination. Two Office Actions were received from the Examiner, and responses were filed. Continued examination was requested on September 12, 2007 to consider an Information Disclosure Statement and a later-filed Rule 132 Declaration by Dr. Mian. On April 1, 2008, a third Office Action rejecting claims 1-2, 5-14, 16-17 and 23-24 was mailed. Applicants filed their response on September 1, 2008.

After a long delay by the PTO and Applicants' filing of two status inquiries, a new examiner was designated. Examiner Gitomer made another restriction requirement of the already examined claims in his Office Action mailed August 11, 2009. Claims 1, 5, 7-11 and 24 were elected and Applicants filed a detailed traversal. The Examiner was not persuaded by that traversal and made the restriction requirement final. At page 2 of his Office Action mailed October 16, 2009, the Examiner alleged "the application has not previously been adequately examined and searched." No evidence was provided by the Examiner to establish that the previous examination was inadequate. In particular, no mistake was cited in Examiner Wood's searches carried out through three different Office Actions on the merits, which are extensively documented in the IFW. After examination of the pending claims in the Office Action mailed April 1, 2008, there is clearly no serious burden to search them all in this patent application, especially since there is no evidence that the previous examination was deficient or improper.

Applicants disagree with Examiner Gitomer's assertion that the second restriction requirement is proper. Unity of invention was previously found by Examiner Wood. All of

the pending claims have already been searched. The PTO's *Manual of Patent Examining Procedure* requires that the previous Examiner's searches be given "full faith and credit" in accordance with M.P.E.P. § 704.01:

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something.

Therefore, claims 12-14 and 16-17 should not be withdrawn from consideration unless clear error in the previous Office Action or knowledge of other prior art is identified. In their response filed September 11, 2009, Applicants requested the Examiner to provide evidence of the clear errors or knowledge of other prior art. But he failed to do so in his Office Action mailed October 11, 2009. Due process requires that the evidentiary basis for another restriction of already examined claims be provided before the Examiner's requirement can be made final.

The present Examiner's new restriction requirement contradicts the instruction in M.P.E.P. § 704.01 that "full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art." Here, no evidence of either clear error or knowledge of other prior art was provided. Even assuming *arguendo* that multiple distinct inventions are claimed in this patent application, restriction is discretionary because a patent may contain such claims (see 35 U.S.C. 121 "The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention"). Therefore, the absence of a requirement to restrict among the pending claims is not clear error in the first restriction requirement. The full faith and credit that should be given to the previous Examiner's search prohibits restriction of subject matter that has already been searched and examined in three different Office Actions on the merits.

Applicants also disagree with the allegation in the Action that the pending claims lack unity of invention, and belong to different groups of inventions. Although they agree with the Examiner's conclusion that the inventions are separately patentable, all of the

pending claims are linked so as to form a single general inventive concept under PCT Rule 13.1. Here, claim 1 is drawn to an assay for determining a subject's coping capacity for exposure to a psychological stressor. The result of the assay can be used in a variety of applications of general interest. In particular, the withdrawn claims 12-14 and 16-17 are directed to methods that use the result obtained by the method according to claim 1. Thus, the nonelected claims require that the method according to claim 1 must be practiced as part of the claimed invention because claims 12-14 and 16-17 depend from claim 1. The pending claims do not lack unity of invention because they all refer to the same assay. Limitations (a) to (e) of claim 1 provide a special technical feature shared by the pending claims. Therefore, unity of invention is established.

Finally, claims 12-14 and 16-17 were rejected in the Office Action mailed April 1, 2008. The second restriction requirement and the Examiner's withdrawal of claims 12-14 and 16-17 from consideration prevent Applicants from resolving rejections made on claims that have been examined and are now withdrawn. But due process requires they be provided a fair opportunity to resolve rejections of claims 12-14 and 16-17 that were made during prosecution. Therefore, claims 12-14 and 16-17 need to be examined in this patent application.

ACTION REQUESTED

As discussed above, Applicants submit that all of the pending claims share a special technical feature. Therefore, having satisfied the requirement of PCT Rule 13 for unity of invention, all of the pending claims should be examined in this U.S. national stage application. Further, the previous examination of claims 1, 5, 7-14, 16-17 and 24 should be given full faith and credit. No serious burden was demonstrated that prevents continued examination of all claims pending in this patent application. Compact prosecution and the public interest would be served by withdrawal of the second restriction requirement.

In the alternative, if the previous examination carried out through three different Office Actions on the merits is found to contain clear error, it is requested that the RCE fee be refunded to our Deposit Account No. 14-1140 under Order No. 3772-38 because

the finding would be an admission by the PTO that Applicants did not receive the proper search and examination expected in previous Office Actions. Further, the RCE should be withdrawn and PTO delay should be calculated from the filing date of May 4, 1005 until the Office Action was mailed on August 11, 2009 since the admission would also establish that Applicants did not receive a proper Office Action from Examiner Wood.

The Director is requested to invoke his supervisory authority over the Examiner's actions to withdraw the restriction requirement and to examine all of the pending claims in the same patent application.

Applicants earnestly solicit grant of this petition. If any further information would assist in this decision, the Director or his designee is invited to contact the undersigned.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /Gary R. Tanigawa/
Gary R. Tanigawa
Reg. No. 43180

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100